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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,805	12/07/1999	SUSAN D. WOOLF	03797.78802	5591

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 03/24/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

V

Office Action Summary

Application No.

09/455,805

Applicant(s)

WOOLF ET AL.

Examiner

Maikhanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3,5,7. 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: original application filed 07/12/1999; IDS filed 03/09/2000, 04/23/2001, 10/24/2002, and 11/27/2002.
2. Claims 1-20 are currently pending in this application. Claims 1, 10, and 16 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cassorla et al.** (U.S. 5,146,552 – filed 02/1990 as cited by IDS filed 10/24/2002) in view of **Admitted Prior Art (APA)**.

As to independent claim 16, Cassorla discloses a computer-readable storage medium comprising computer-executable instructions for performing steps comprising:

- annotating parts of a currently displayed page in accordance with movement of a user input device to indicate where on the currently displayed document page the annotations should appear (The association of annotations with a particular context within the document

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exploits the fact that the writer in constructing an electronically published document has indicated the structure of the document by "marking up" the material and identifying major document elements such as chapters, sections, sub-sections, paragraphs, figures, etc.; col.2, lines 16-55); and

- storing annotations made in step (2) in a data structure separate from the electronic document (The record of such annotations or "place marks" can be stored within or separately from the published material. Annotations stored separately from the originally published document are associated by name with the document and can either be accessed by a particular individual reader and/or shared and exchanged between individuals with access to the same 'or copies of the' published electronic document for a variety of purposes; col.2, lines 16-55).

However, Cassorla, does not explicitly disclose "displaying an electronic document page on a computer display device and permitting a user to move forward and backward among a plurality of document pages."

APA discloses:

- displaying an electronic document page on a computer display device and permitting a user to move forward and backward among a plurality of document pages (Web browsers typically provide functions which permit a user to advance forward and backward among a series of related pages; Background; page 1, lines 17-22).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Cassorla because it would have provided the capability for allowing a user to add annotations and other markings to document pages.

As to dependent claim 17, Cassorla discloses instructions for creating an opaque annotation that obscures annotated portions of the currently displayed document (Fig.1).

As to dependent claim 18, Cassorla discloses instructions for creating a translucent annotation that does not completely obscure annotations portions of the currently displayed document, wherein the translucent annotation is generated by blending pixels from the currently displayed document with a highlighting pixel color (several types of annotations... This type of annotation is typically accomplished by underlining, color "highlighting" or margin "flags" in material printed on paper; col.4, lines 4-42).

As to dependent claim 19, Cassorla discloses instructions for erasing portions of previously created annotations (Fig.1).

As to dependent claim 20, Cassorla discloses a. in response to detecting that the user has moved to a different document page, retrieving previously stored annotations associated with the different document page; and b. displaying the annotations retrieved in step (a) on the different document page (Fig.5).

Independent claim 1 is directed to a method for performing the computer-readable storage medium of claim 16, and is similarly rejected under the same rationale.

However, claim 1 further recites "selecting an annotation mode that permits the user to annotate the currently displayed document page."

Cassorla discloses selecting an annotation mode that permits the user to annotate the currently displayed document page (The operating principle permits a reader of an electronically published document to create notes, bookmarks, or annotations and relate them to a particular location in the document; col.2, lines 16-55).

As to dependent claim 2, Cassorla discloses the step of using opaque markings that obscure portions of the currently displayed document page (Fig.1).

As to dependent claim 3, Cassorla discloses the step of using a translucent highlighting (highlighting) that does not completely obscure the annotated portions of the currently displayed document page (col.6, lines 51-68).

As to dependent claim 4, Cassorla discloses the step of blending pixels from the currently displayed document with a translucent color to produce a translucent annotation (Several types of annotations... color, type style, etc. be recorded; col.4, lines 4-43).

As to dependent claim 5 includes the same limitations as in claim 19, and is similarly rejected under the same rationale.

As to dependent claim 6, Cassorla does not explicitly disclose the step of using a stylus with a tablet computer system.

APA discloses the step of using a stylus with a tablet computer system (tablet and stylus; Background; page 1, lines 23-27).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Cassorla because it would have provided the capability for allowing a user to add annotations and other markings to document pages.

As to dependent claim 7, Cassorla discloses the step of storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated (Fig.1).

As to dependent claim 8, Cassorla discloses moving to a different document page; retrieving previously stored annotations associated with the different document page; and displaying the retrieved annotations on the computer display device superimposed over the different document page (Fig.3 and col.6, lines 51-68).

As to dependent claim 9, Cassorla discloses the step of detecting a title change event in the document browser and, in response thereto, locating an annotation file corresponding to the different document page (Fig.4).

Independent claim 10 is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

As to dependent claims 11-12 include the same limitations as in claims 2-3, and are similarly rejected under the same rationale.

As to dependent claim 13, Cassorla discloses the computer software displays and stores erased annotations that remove previously made annotations on the currently displayed document page (fig.3).

As to dependent claim 14, Cassorla does not explicitly disclose a flat panel display, and wherein the computer input device comprises a stylus.

APA discloses a flat panel display, and wherein the computer input device comprises a stylus (tablet and stylus; Background; page 1, lines 23-27).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Cassorla because it would have provided the capability for allowing a user to add annotations and other markings to document pages.

As to dependent claim 15, Cassorla discloses upon detecting a title change event, previously stored annotations associated with a different document page and displays the previously stored annotations on the different document page (Fig.3 and col.6, lines 51-68).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rivette et al.	U.S Patent No. 6,389,434	issued dated: May 14, 2002
Sidana	U.S Patent No. 6,081,829	issued dated: Jun. 27, 2000
Pacifici et al.	U.S Patent No. 6,230,171	issued dated: May 8, 2001
Graham et al.	U.S Patent No. 6,369,811	issued dated: Apr.9, 2002
Morgan et al.	U.S Patent No. 5,239,466	issued dated: Aug. 24,1993

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

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Contact Information:

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.

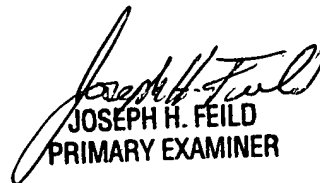
OFFICIAL faxes must be signed and sent to (703) 746-7239.

NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
March 20, 2003


JOSEPH H. FEILD
PRIMARY EXAMINER